

## **REMARKS**

Claims 1-43 are pending in the Application. Claims 40-43 have been added. No new matter has been added. Entry of the amendment is respectfully requested. Reconsideration is respectfully requested.

### **The 35 U.S.C. § 103 Rejections**

For brevity the Applicant has not necessarily presented all the reasons as to why the applied references do not render the claims obvious. The Applicant reserves the right to later present additional reasons. Nevertheless, Applicant's arguments show that the applied references do not disclose or suggest all of the features, relationships, and steps of the claimed invention. Hence, Applicant's claims patentably distinguish over the applied references. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections should be withdrawn.

### **The Legal Standard**

Before a claim may be rejected on the basis of obviousness, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Applicant is under no obligation to submit evidence of nonobviousness. MPEP § 2142.

Absent a showing of a teaching, suggestion, or motivation to produce a claimed combination, an obviousness rejection is not proper. *Panduit Corp. v. Denison Mfg. Co.*, 810

F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

It is respectfully submitted that the Action does not meet these burdens.

**The Claims Are Not Obvious Over  
Phillips in view of Gatto**

Claims 1-37 were rejected under 35 U.S.C. § 103(a) as obvious over Phillips et al. ("Phillips") in view of Gatto. These rejections are respectfully traversed. The Office has not presented a *prima facie* showing of obviousness.

**Claim 1**

The Action admits that Phillips does not teach or suggest having a facility remote from a self-service dispensing machine. The Action further admits that Phillips does not relate to requesting an amount of cash, charging for the amount of cash, or delivering the amount of cash.

Gatto cannot overcome the admitted deficiencies of Phillips as it does not disclose or suggest the recited features which are not found in Phillips. The Action is silent as to how Phillips could be modified by Gatto to include the recited features and relationships. The Action is devoid of any such teaching, suggestion, or motivation for combining the references. Neither

Phillips nor Gatto, taken alone or in combination, disclose or suggest the features and relationships that are specifically recited in the claims.

The Action alleges that it would have been obvious to have placed Phillips' second goods dispensing apparatus in the mini-market facility. The Applicant disagrees.

As admitted in the Action, Phillips' second goods dispensing apparatus is not associated with cash dispensing. Phillips' second goods dispensing apparatus is associated with a vending machine (3) for vending canned drinks (col. 3, lines 1-7). The vending machine (3) is located on a pump island of a vehicle fueling facility. The vending machine (3) does not dispense requested cash.

Furthermore, it would not have been obvious to have located Phillips' second goods dispensing apparatus at a facility remote from the pump island. Phillips provides no teaching, suggestion, or motivation for (remotely) locating the vending machine (3) inside of a mini-market. On the contrary, Phillips teaches that his invention solves the prior art problems by locating the vending machine on a pump island of a vehicle fueling facility (col. 2, lines 62-67; col. 7, lines 32-35). The vending machine (3) is "proximate to a self serve fuel dispensing pump 1" (col. 3, lines 15-16; Figure 3). Additionally, Phillips desires that the vending machine be close to the fuel pump so that a user is able to purchase and drink a soft drink while pumping gas (col. 26, lines 46-49).

Furthermore, it would not have been obvious to have placed Phillips' vending machine inside of a mini-market, as the Action has alleged. One skilled in the art would recognize that it would not have been obvious for a user in Phillips to leave the fuel pump island (and the vehicle holding children) to go inside a mini-market to use a vending machine when they can purchase

the same item at the island. Nor would one skilled in the art look to use a vending machine inside a mini-market when they can purchase the same item (and other items) at the checkout counter. Nor would it be obvious to locate a vending machine in a space-limited mini-market where the owner may be prevented from marking up the price of the item vended. Thus, it would not have been obvious to have placed Phillips' second goods dispensing apparatus in a mini-market facility.

Gatto cannot alleviate the deficiencies in Phillips as it does not disclose or suggest the recited features which Phillips lacks. Gatto, being similar to Phillips, is limited to transactions adjacent the fuel pump. Gatto is not concerned with a facility remote from the fuel pump. Nor is Gatto concerned with delivering a requested amount of cash at a facility remote from the fuel dispenser. Nor does Gatto disclose or suggest receiving a cash request input adjacent the fuel dispenser and delivering the requested cash at a facility remote from the dispenser.

Neither Phillips nor Gatto disclose or suggest a link between their fuel dispenser and a facility (having a cash supply) remote from the dispenser. Neither Phillips nor Gatto disclose or suggest delivering information representing a cash request to a facility remote from their dispenser. Additionally, neither Phillips nor Gatto disclose or suggest receiving the cash request input adjacent their fuel dispenser. Nor has the Action presented any factual evidence that it was known in the prior art to request cash adjacent a self-service dispensing machine, and to deliver the requested cash to a user at a facility remote from the dispensing machine.

Furthermore, even if it were somehow possible for Phillips' second goods dispensing apparatus to dispense cash (which it isn't), then it still would not have been obvious to have placed the dispensing apparatus in a mini-market facility, as previously discussed.

Furthermore, even if it were somehow possible to combine Phillips with Gatto's teaching (which it isn't), this would not render the resultant combination obvious because Phillips does not suggest the desirability of the combination (MPEP § 2143.01).

The attempts to modify Phillips are clearly attempts at hindsight reconstruction of Applicant's claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 22 USPQ2d 1780 (Fed. Cir. 1992). The rejection, which lacks the necessary evidence and rationale, is based on knowledge gleaned only from Applicant's disclosure.

The Office has not presented a *prima facie* showing of obviousness. If the Office does not produce a *prima facie* case, which is the current situation, then Applicant is under no obligation to submit evidence of nonobviousness. MPEP § 2142.

Nevertheless, Applicant has shown that neither Phillips nor Gatto disclose or suggest the recited steps, features, and relationships. Nor would it have been obvious to have combined the teachings of Phillips and Gatto. Nor would it have been obvious to have combined the teachings of Phillips and Gatto to have produced Applicant's recited invention. Furthermore, Applicant has also shown that even if it were somehow possible for Phillips to include the teachings of Gatto, the modified Phillips would still lack the recited steps, features, and relationships. It follows that neither Phillips nor Gatto, taken alone or in combination, disclose or suggest the steps, features, and relationships that are specifically recited in the claim. Thus, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection should be withdrawn.

### **The Dependent Claims**

Each of the dependent claims 2-37 depend directly or indirectly from claim 1. Claim 1 has been previously shown to be allowable. It is asserted that these dependent claims are allowable on the same basis.

Furthermore, each of these dependent claims additionally recite specific steps, features, and relationships that patentably distinguish the claimed invention over the applied art. Neither Phillips nor Gatto, taken alone or in combination, disclose or suggest the steps, features, and relationships that are specifically recited in these dependent claims. Thus, it is respectfully submitted that these dependent claims are further allowable due to the recitation of such additional steps, features, and relationships.

For example, neither Phillips nor Gatto teach or suggest providing a user with other merchandise at a remote facility, where the other merchandise has an associated cost, and receiving payment of the cost from the user in cash. Note claim 3. Neither Phillips nor Gatto teach or suggest receiving cash payment of other merchandise at a remote facility.

Applicant also traverses the rejection based on alleged "official notice" presented in Paragraph 11 of the Action. Applicant respectfully submits that there is no prior art teaching, suggestion or motivation to produce the recited methods.

### **The 35 U.S.C. § 102 Rejections**

For brevity the Applicant does not necessarily present all of the reasons as to why the Phillips reference does not anticipate the claims. The Applicant reserves the right to later present additional reasons. Nevertheless, Applicant's arguments herein show that the reference does not

disclose each and every step, feature, and relationship of the claimed invention arranged in the manner recited in the claims, as is required to sustain the rejections. Therefore, the applied reference cannot anticipate the claims. Hence, Applicant's claims patentably distinguish over the applied reference. Therefore, it is respectfully submitted that the 35 U.S.C. § 102(e) rejections should be withdrawn.

### **The Legal Standard**

Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Anticipation under 35 U.S.C. § 102 requires in a single prior art disclosure, each and every element of the claimed invention in a manner such that the reference would literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barient, Inc.*, 822 F.2d 744, 747, 3 USPQ2d 1766, 1768 (Fed. Cir. 1987).

It is respectfully submitted that the Action does not meet these burdens.

### **The Claims Are Not Anticipated By Phillips**

In the Action claims 38-39 were rejected under 35 U.S.C. § 102(e) as being anticipated by Phillips. These rejections are respectfully traversed.

### **Claim 38**

Phillips does not teach the recited features and relationships. Phillips does not teach a code which corresponds to a difference between a merchandise charge and an amount of cash accepted.

Even if Phillips' vending machine permits accepting cash, there isn't any indication that Phillips generates a code corresponding to vending machine change. There is no indication that Phillips' fuel dispenser permits accepting cash.

Furthermore, if Phillips' vending machine is alleged as the first dispensing machine (because of cash acceptance) then it follows that Phillips' fuel dispenser must be alleged as the second dispensing machine. However, there isn't any indication in Phillips that a generated code can be used to pay for merchandise at a fuel dispenser.

Where does Phillips teach paying for first merchandise (at a first dispensing machine) with cash, generating a code corresponding to the change, and paying for second merchandise (at a second dispensing machine) using the code? Phillips cannot anticipate the claim. Therefore, it is respectfully submitted that the 35 U.S.C. § 102(e) rejection should be withdrawn.

### **Claim 39**

Claim 38 has been previously shown to be allowable. It is asserted that claim 39, which depends from claim 38, is allowable on the same basis. Furthermore, claim 39 additionally recite specific steps, features, and relationships that patentably distinguish the claimed invention over Phillips. Thus, it is respectfully submitted that the 35 U.S.C. § 102(e) rejection should be withdrawn.



**Fees For Additional Claims**

Please charge the fees associated with the submission of four (4) claims in excess of twenty claims (\$72) and any other fee due to deposit account 09-0428.

## Versions With Markings To Show Changes Made

### In the Claims

1. (once amended) A method comprising [in any order the steps of]:

- a) paying a charge for merchandise delivered to a user at a self-service dispensing machine, including reading a machine readable article, wherein the article corresponds to a source of monetary value;
- b) receiving an input from the user through an input device adjacent the dispensing machine, wherein the input corresponds to a request for an amount of cash;
- c) charging the source of monetary value for the charge and the amount;
- d) communicating information representative of the request for the amount to a facility remote from the

machine, wherein the facility includes a supply of  
cash; and

- e) delivering the amount of cash to the user from the  
supply after the user arrives at the facility.

21. (once amended) The [apparatus] method according to claim 20 wherein the machine further comprises an output device, and further comprising the step of providing a prompt message through the output device advising the user to press at least one of the keys if they wish to receive an amount of cash.

23. (once amended) The method according to claim 22 wherein step (e) [(f)] comprises at least one of either reviewing the machine readable article, reviewing a driver's license associated with the user, or receiving a biometric input from the user.

24. (once amended) The method according to claim 1 wherein the self-service dispensing machine is operative to deliver motor fuel in an outdoor environment, and wherein the facility includes an indoor sales area [adjacent to the self-service dispensing machine], wherein in step (e) the amount is delivered in the sales area.


39. (once amended) The method according to claim 38, wherein the outputting step further includes dispensing an item that includes indicia representative of the code, and wherein the second charge paying step further includes reading the indica from the item.

### Conclusion

Each of Applicant's pending claims specifically recite features and relationships that are neither disclosed nor suggested in any of the applied prior art. Furthermore, the applied prior art is devoid of any such teaching, suggestion, or motivation for combining features of the applied art so as to produce Applicant's invention. Allowance of all of Applicant's pending claims is therefore respectfully requested.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Examiner's convenience.

Respectfully submitted,



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